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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,960	01/15/2002	David W. Stebbings	110267.201US2	3106

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Hale and Dorr LLP
1455 Pennsylvania Avenue, N.W.
Washington, DC 20004

EXAMINER	
VARGOT, MATHIEU D	

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/044,960	STEBBINGS ET AL.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 January 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15,17,18 and 24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15,17,18 and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *1/15/02* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1.Claims 15, 17, 18 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 15, 17 and 18, lines 1-2, the recitation "at least one of comprised of and including a portion of" is stilted language which would better be replaced with --comprised of a polymer--. Also, these claims later recite "the polycarbonate material", and this language should be put in the preamble (ie, lines 1-2) to provide antecedent basis for the later recitation of the particular polymer used. Claims 15, 17 and 18 also go on to recite "the data stored on the product", and this language also lacks antecedent basis in the claims and should properly be also put into the preamble to provide antecedent basis for language set forth later in the claims. Ie, "product" at line 1 should be changed to --data disc--. Claim 24 is indefinite in calling for a method without positively reciting any steps. This claim should be reworded to include steps.

2.The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Cyr et al (see col. 1, lines 48-5; col. 2, lines 55-60; and col. 4, lines 57-65).

The applied reference discloses the instant system for marking a polymer product with a means for introducing a tracing substance into a polycarbonate material used to make the substrate of the product, the tracing substance being used in an amount that does not affect the performance of the data on the product (see col. 4, lines 57-59 concerning the reading of the data) and a product manufacturing system operatively connected to the substance introducing system.

3.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyr et al in view of Aratani et al (see col. 1, line 45).

The primary reference discloses the basic claimed process and system as set forth in paragraph 2, supra, Cyr et al essentially lacking a clear showing that the protective layer of the product is made from polycarbonate. Note that Cyr et al (see column 4, lines 60-65) contains a disclosure to incorporating the tracing substance in either the substrate or a protective layer and/or any one of the layers shown in Figure 1 of the reference. Hence, the disclosure of the primary reference includes incorporating the substance into a protective layer of the product. Aratani et al, at column 1, line 45, discloses that it is conventional to make protective layers from polycarbonate and one of ordinary skill in the art would have modified the method and system of Cyr et al as taught in the prior art of Aratani et al to form a disk of greater strength.

4.Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cyr et al in view of Kane et al (see col. 1, lines 47-50; col. 2, lines 41-43; and col. 7, lines 29+ and col. 8, lines 11-20).

Cyr et al is applied for reasons of record, the primary reference disclosing the basic claimed method lacing essentially the aspects of the tracing substance including predetermined concentration amounts of an isotope, such being indicative of the manufacturer or manufacturing date. Kane et al discloses these aspects in labeling optoelectronic articles and such would have been an obvious modification to the method of Cyr et al for a more comprehensive control over the movement and whereabouts of the optical disks. Again, since the primary reference discloses incorporating the tracing substance in the substrate or reflective layer, it is submitted that the instant language "a data message impregnated with...tracing substance" would have been at least obvious thereover.

5.The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6.Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,477,134 in view of Cyr et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 15 differs from the claims of previously issued US patent –134 only in the aspect of marking the protective layer, such clearly shown in Cyr et al as being obvious over marking any other portion of the optical disk.

7.Claim 24 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,477,134 in view of Kane et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 24 recites over claim 3 of the previously issued US Patent -134 at most the limitations of how the isotopes are used, such clearly shown in Kane et al and an obvious modification to claim 3 of –134 for a more comprehensive tracking of the optical disks.

8.The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Crihan (col. 2, lines 11+) discloses mixing radioisotopes with polymers to identify works of art.

9.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot
December 27, 2003

Mathieu D. Vargot
Primary Examiner
Art Unit 1732

12/27/03